

REMARKS

Status of the Claims

Claims 1-14 are pending in this application. No claims have been canceled or added. Claim 1 has been amended to clarify that the invention includes at least one second compound having a formula that satisfy (iv) and having characteristics that satisfies at least one of (i) to (iii). No new matter has been added by the above claim amendments.

Rejection under 35 USC 112, first paragraph

The Examiner rejects claims 1-14 under 35 U.S.C. § 112, first paragraph as containing subject matter that is not described in the specification to indicate that Applicants were in possession of the subject matter at the time of filing. Applicants traverse the rejection and respectfully request the withdrawal thereof.

The Examiner states that the claim limitation stating that at least one compound of (iv) and at least one of (i)-(iii) is not supported by the original disclosure. Applicants submit that the specification supports alternative embodiments of (i)-(iv) and any combination thereof. See page 76, last two paragraphs where it is disclosed that the compounds of item (iv) may be used alone or in combination. Therefore, requiring that a compound that satisfies (iv) is always present is not new matter. For example, from the teachings in the specification, particularly page 76, one can

envision alternative embodiments of the invention that include any of the following combinations: (a) a compound that satisfies only (iv), (b) a compound that satisfies only (iv) and (i), (c) a compound that satisfies only (iv) and (ii), (d) a compound that satisfies only (iv) and (iii), etc.

As such, Applicants submit that the specification supports the claimed embodiment where the compound satisfies (iv) and at least one of (i) to (iii). Thus, Applicants respectfully request that this rejection be withdrawn.

Rejection under 35 USC 112, second paragraph

The Examiner rejects claims 1-14 under 35 U.S.C. § 112, second paragraph as indefinite. The Examiner objects to the claim language of at least one compound satisfying (iv) and at least one of (i)-(iii). The Examiner states that this language is indefinite because of the reference to compounds of the formulas (1), (2) or (3). The Examiner is also confused about whether the language means a combination of a compound that satisfies (iv) and a compound that satisfies (i) to (iii) as the nucleating agent. Applicants traverse the rejection and respectfully request the withdrawal thereof.

Applicants amend claim 1 to recite "at least one second compound having a formula satisfying (iv) that has characteristics satisfying at least one of (i) to (iii)". Applicants submit that

it is clear from the amendment that the present invention does not intend to use at least one compound of (iv) and at least one other compound of (i) to (iii). Thus, Applicants particularly and distinctly claim the subject matter of the invention. As such, the rejection should be withdrawn.

Rejection under 35 USC 103(a)

The Examiner maintains the rejection of claims 1-14 as obvious over Ito '084 in view of JP '136 or Adin '260. Applicants traverse the rejection and respectfully request the withdrawal thereof.

Applicants submit that any alleged prima facie case of obviousness established by the Examiner is rebutted by the attached Declaration of Mr. Yamaguchi, which shows unexpected superior properties of the present invention over the closest prior art.

Mr. Yamaguchi prepared photothermographic samples according to Ito '084 and evaluated each of them by the method described in the present specification. Please see the table on page 3 of the Declaration for the results of the comparative tests. Please see samples A-4 A-6, A-8 and A-10, which represent the present invention. From the comparative data, it can be concluded that high sensitivity and low fog after long storage can be achieved by using the combination of a compound of the present invention and a compound of formula (I).

Moreover, Applicants submit that one of ordinary skill in the art would not be motivated to select the compounds of the present invention from amongst the various compounds exemplified in Ito '084. Applicants submit that even if there were some motivation to make the Examiner's suggested combination, one of ordinary skill would not expect to achieve the superior properties of the present invention, namely low fog, excellent sensitivity, high Dmax and high contrast. As such, this rejection should be withdrawn.

Conclusion

As Applicants have addressed and overcome all rejections in the Office Action, Applicants respectfully request that the rejections be withdrawn and that the claims be allowed.

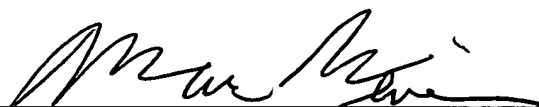
Pursuant to 37 C.F.R. §§ 1.17 and 1.136(a), Applicant(s) respectfully petition(s) for a one (1) month extension of time for filing a reply in connection with the present application, and the required fee of \$110.00 is attached hereto.


Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Kecia Reynolds (Reg. No. 47,021) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By 
Marc S. Weiner, #32,181


MSW/KJR/jmb
2870-0177P

P.O. Box 747
Falls Church, VA 22040-0747
(703) 205-8000

Attachment(s): Declaration under 37 C.F.R. 1.132

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